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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,048	05/09/2006	Minerva M. Yeung	42P17842	6284
8791 7590 11/12/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
LAM, VINH TANG				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,048

Applicant(s)

YEUNG ET AL.

Examiner

VINH T. LAM

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 06/07/2006 & 05/09/2006

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **518** (Figure **5**), **910** and **914** (Figure **9**). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims **1-22** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter: The recitation of the claim 1 and 19 , lines 1-2

recites "**computer-implemented method correlated to printed material**" and the recitation of claim 10, line 2 "**machine accessible instruction**" could be a carrier wave as stated in the specification and defined as a *Carrier Wave* (Col.6, [0052]) is a non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims **1-5, 8-14, and 17-22** are rejected under 35 U.S.C. 102(b) as being anticipated by **Ohara et al. (Us Patent No. 5739814)**.

Regarding Claim **1**, **Ohara et al.** teach a computer-implemented method of correlating printed material to a response produced by a computer system comprising:

defining an object on a page of the printed material (Col. **4**, Ln. **17-31**, FIG. **1**);
and

linking a position of the object on the page, and a related response to be performed by the computer system (Col. **4**, Ln. **17-31**, FIG. **1**).

Regarding Claim **10**, **Ohara et al.** teach an article comprising:

a storage medium having a plurality of machine accessible instructions (Col. **4**, Ln. **26**, FIG. **1**),

wherein when the instructions are executed by a processor, the instructions provide for correlating printed material to a response produced by a computer system by defining an object on a page of the printed material (Col. 4, Ln. 26-29, FIG. 1); and linking a position of the object on the page and a related response to be performed by the computer system (Col. 4, Ln. 29-31, FIG. 1).

Regarding Claim 19, **Ohara et al.** teach a system for associating a selected object on any printed material to a valid response provided by a computer system comprising:

- a pointing device to determine a position on the printed material (Col. 6, Ln. 4-7, FIG. 5);

- a communicating device to transmit the position to the computer system (Col. 6, Ln. 20-23, FIG. 5);

- a maker component to define an object on a page of the printed material (Col. 4, Ln. 17-31, FIG. 1); and

- to link a position of the object on the page and a related response to be performed by the computer system (Col. 4, Ln. 17-31, FIG. 1); and

- a player component to correlate the pointed position to selected content associated with the printed material, the selected content being accessible by the computer system (Col. 4, Ln. 63-68, Col. 5, Ln. 1-2, FIG. 2); and

- to provide a valid response to a user based at least in part on the pointed position and the correlated content, wherein the valid response includes at least one of rendering audio content, rendering video content, rendering image content, rendering

text content, and performing an action by the computer system (Col. 5, Ln. 27-59, FIG. 3).

Regarding Claims 2 and 11, **Ohara et al.** teach the computer-implemented method of claim 1 and the article of claim 10 respectively, wherein the response comprises at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system (Col. 4, Ln. 63-68, Col. 5, Ln. 1-4, FIG. 2).

Regarding Claims 3 and 12, **Ohara et al.** teach the computer-implemented method of claim 2 and the article of claim 11 respectively, further comprising generating a multimedia database to store digital multimedia content including at least one of audio content, video content, image content, and text content; a printed material content database to store positional information about objects on the pages and linkage information between the objects and at least one of the multimedia contents and actions; and an action library to store directives for actions to be performed on the computer system (Col. 5, Ln. 27-65, FIG. 3).

Regarding Claims 4 and 13, **Ohara et al.** teach the computer-implemented method of claim 2 and the article of claim 11 respectively, wherein defining the object on the page comprises using an electronic pen to outline boundaries of the object on the page (Col. 6, Ln. 3-16, FIG. 5).

Regarding Claims 5 and 14, **Ohara et al.** teach the computer-implemented method of claim 2 and the article of claim 11 respectively, wherein defining

the object on the page comprises using an electronic pen to select key points on the boundary of the object on the page (Col. 6, Ln. 3-16, FIG. 5).

Regarding Claims 8, 17 and 22, **Ohara et al.** teach the computer-implemented method of claim 2, the article of claim 11, and the system of claim 19 respectively, wherein the printed material comprises a traditional paper book (Col. 4, Ln. 17-20, FIG. 1).

Regarding Claims 9 and 18, **Ohara et al.** teach the computer-implemented method of claim 2 and the article of claim 11 respectively, wherein the printed material comprises material generated by a user (Col. 5, Ln. 62-65, FIG. 4).

Regarding Claim 20, **Ohara et al.** teach the system of claim 19, wherein the pointing device comprises an electronic pen (Col. 6, Ln. 3-16, FIG. 5).

Regarding Claim 21, **Ohara et al.** teach the system of claim 19, further comprising a multimedia database to store digital multimedia content, a printed material content database to store positional information about objects on the pages and linkage information between the objects, and at least one of the multimedia contents and actions, and an action library to store directives for actions to be performed on the system (Col. 5, Ln. 27-65, FIG. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **6-7** and **15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ohara et al. (Us Patent No. 5739814)**.

Regarding Claims **6** and **15**, **Ohara et al.** teach the computer-implemented method of claim 2 and the article of claim 11 respectively, wherein defining the object on the page comprises using a mouse to manipulate a graphical object on a display to encapsulate the boundary of the object on the page as displayed on the display is well-known.

Regarding Claims **7** and **16**, **Ohara et al.** teach the computer-implemented method of claim 2, wherein defining the object on the page comprises using a mouse to select key points on the boundary of the object on the page as displayed on a display is well-known.

Conclusion

The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure are: Zetts (US Patent No. 5404458), Yamamoto et al. (US Patent No. 6040825), Yasuhara et al. (US Patent No. 6191777), Ohara et al. (US Patent No. 6297812), Blume (US Patent No. 7081885), Silverbrook et al. (US Patent No. 7091960), Wood et al. (US Patent No. 7106309), and Sawada et al. (US Patent No. 7283129).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH T. LAM whose telephone number is (571)270-3704. The examiner can normally be reached on M-F (7:30-5:00) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amare Mengistu can be reached on 571 272 1206. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VTL/

/Amare Mengistu/
Supervisory Patent Examiner, Art Unit 2629